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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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11/18/2003

James D. Ralph

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7590

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SPINE MP

LERNER, DAVID, et al.

600 SOUTH AVENUE WEST

WESTFIELD, NJ 07090

EXAMINER

PHILOGENE, PEDRO

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/715,965	Applicant(s) RALPH ET AL.	
	Examiner Pedro Philogene	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-10,20,21,23,26,29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-10,20,21,23,26,29,30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-10, 20, 21, 23, 26, 29, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohrs et al (6,855,166) in view of Kuras (6,607,558).

With respect to claims 1, 4-10, 20, 21, 23, 26, 29, 30, Kohrs discloses an intervertebral spacer device (100) comprising a spacer body dimensioned to fit between two vertebrae, the spacer body having a plurality of outer surfaces, a leading end and a trailing end, as best seen in FIG.6, the plurality of outer surfaces including a first outer surface or convexly curved upper surface (106) extending between the leading end and the trailing end of the spacer (100) and a second outer surface or a convexly curved lower surface (108) extending between the leading end and the trailing end of the spacer body (100), the upper and lower surfaces or the first and second outer surfaces facing away from one another, as best seen in FIG.6, the spacer body having a plurality of linear grooves (101, 102, 103, 104, 109, 110, 111, 120, 121, 122, 123) engageable by an intervertebral spacer insertion tool (500) having a plurality of linearly extending grooves engagement members, the plurality of linear grooves including a first linear groove formed in the first outer surface and a second linear groove formed in the second outer surface, the first and second linear grooves being parallel to one another (the grooves at the end (109) are parallel to grooves at the end (111)); as best seen in

FIG.6. Each of the first and second outer surfaces is convex; as best seen in FIG.6. The first outer surface is an upper surface of the spacer body and the second outer surface is a lower surface of the spacer body; as best seen in FIG.6. The plurality of linear grooves comprises a first set of linear grooves formed in the first outer surface and a second set of linear grooves formed in the second outer surface, the first set of linear grooves being parallel to the second set of linear grooves; as best seen in FIG.6, each linear groove in the first set of linear grooves is directly opposite a respective one of the linear grooves in the second set of linear grooves; as best seen in FIG.6; the grooves are the parallel channels in the upper and lower convex surfaces in between (101, 103 and 102,104). The spacer body comprises a porous material, selected from porous metal, as set forth in column 3, lines 49-56, each of the first and second linear grooves has a smooth surface; as best seen in FIG.6, one of the first and second outer surfaces is rough, as best seen in the figures.

With respect to claims 4, it is noted that Kohrs did not teach of a pillow shape having rounded corners and rounded edges; as claimed by applicant. However, this particular configuration is nothing more than one of numerous configurations one of ordinary skill in the art would find obvious for the purpose of providing mating surfaces in the spacer of Kohrs. See in re Dailey 149 USPQ 47 (CCPA 1976).

It is noted that Kohrs did not teach of upper and lower surfaces being convexly curved along a plane extending between the leading and trailing ends and along a plane extending between the first and second sides; as claimed by applicant. However, in a similar art, Kuras evidences the use of an implant having upper and lower surfaces

being curved along a plane extending between the leading and trailing ends and along a plane extending between the first and second sides to resist relative movement between the convex surface and the vertebra and to provide a relatively long fatigue life for the disc.

Therefore, given the teaching of Kuras, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Kohrs et al; as taught by Kuras, to resist relative movement between the convex surface and the vertebra and to provide a relatively long fatigue life for the disc.

Response to Arguments

Applicant's arguments filed 3/11/08 have been fully considered but they are not persuasive. In response to applicant's argument that the two references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the reference to Kohrs discloses all the limitations, even the upper and the lower surfaces of the device being convexly curved along a plane extending between the first and second sides. It is noted that Kohrs does not teach of a device having upper and lower surfaces that are convexly curved form a plane extending from a leading end to a trailing end; as claimed by applicant. However, the device to Kuras has upper and lower surfaces that are convexly curved all around, from front to back and side to side. Under the correct analysis, any need to or problem

known in the field and addressed by the patent can provide a reason for combining the elements in the manner claimed. A person of ordinary skill in the art attempting to solve a problem will be led to prior art elements designed to solve the same problem.

Applicant wrongly concluded that because "kuras discloses an artificial disc that is meant to replicate the operation of the spinal disc when implanted between two adjacent vertebrae", Kohrs would not have used the same shape (convex surface) on the surface of his device. It is common sense that familiar items may have obvious uses beyond their primary purpose, and a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle. Regardless of Kohrs's primary purpose, it provide an obvious example of a spacer with a convex curved surface, and the prior art was replete with patents indicating that such a shape is ideal for a spacer. Where there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill in the art has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In the present instance the fact that a combination was obvious to try shows that it was obvious under 103.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pedro Philogene/
Primary Examiner, Art Unit 3733
June 16, 2008